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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,659	10/28/2003	Masahiro Inomata	3140-017	3997
33432	7590	10/17/2005		
KILYK & BOWERSOX, P.L.L.C. 400 HOLIDAY COURT SUITE 102 WARRENTON, VA 20186			EXAMINER PRITCHETT, JOSHUA L	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/694,659

Applicant(s)

INOMATA, MASAHIRO

Examiner

Joshua L. Pritchett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☒ Claim(s) 1-30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

This action is in response to Amendment after non-final rejection filed August 11, 2005.  
Claims 1-9 have been amended and claims 12-30 have been added as requested by the applicant.

### ***Claim Objections***

Claims 1-30 are objected to because of the following informalities:

The use of the term “simple” to distinguish between two different observation condition settings and observations images is confusing. The examiner suggests changing the claim language to say “a first observation condition setting” and “a second observation condition setting” to allow the claimed to be more readily understandable.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 16-24, 26, 27 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Bacus (US 6,396,941).

Regarding claims 1, 10 and 11, Bacus discloses a magnifying observation apparatus comprising a simple observation condition setting section for setting simple observation conditions for simply acquiring a plurality of observation images (Fig. 1A); a simple observation image display for displaying a plurality of simple observation images acquired per the plurality of simple observation conditions set with the simple observation condition setting section (col. 6 lines 42-45); a selection section for selecting a desired simple observation image form among the plurality of simple observation images displayed on the simple observation image display section (Figs. 2-3; col. 6 lines 43-50); an observation condition setting section enabling to set further observation conditions based on the simple observation conditions set to the simple observation image selected with the selection section (col. 3 lines 43-50); and an observation image display section for displaying an observation image acquired based on the observation conditions set with the observation conditions setting section (Figs. 2-3). Bacus further discloses photographing an observation image (col. 5 lines 10-17).

Regarding claim 2, Bacus discloses a simple observation image acquisition section for acquiring simple observation images per the plurality of simple observation conditions set with the simple observation condition setting section (Fig. 1A); a simple observation image storage section for storing a plurality of simple observation images acquired with the simple observation image acquisition section (Fig. 1B); an observation image acquisition section for acquiring an observation image based on the observation conditions set with the observation condition setting

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section (col. 6 lines 42-45), wherein the simple observation image display section displays the plurality of simple observation images stored into the simple observation image display section and the observation image display section displays the observation image acquired with the observation image acquisition section (Figs. 2-3; col. 5 line 10 – col. 7 line 4).

Regarding claim 3, Bacus discloses the simple observation image display section lists a plurality of simple observation images (col. 6 lines 42-45).

Regarding claim 4, Bacus discloses the simple observation image display section comprises a switch section for selectively displaying the plurality of simple observation images (col. 6 lines 42-45).

Regarding claim 5, Bacus discloses an adjustment section for performing at least positioning and focusing on an observation image displayed on the observation image display section before setting simple observation conditions by the simple observation condition setting section (col. 5 lines 40-48).

Regarding claim 6, Bacus discloses the simple observation conditions set with the simple observation condition setting section include illumination method (col. 18 lines 5-12) and brightness of an image (col. 18 lines 5-12).

Regarding claim 7, Bacus discloses the adjustment method is made by way of selecting between incident-light illumination and transmitting illumination as an illumination direction, selection between peripheral illumination and side illumination, and selection among a diffuser, a polarizer and a transmitted light without using filters as a filter for an illumination light (col. 18 lines 5-12).

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Regarding claim 8, Bacus discloses control of the brightness of an image is done by at least one of control of the light quantity of the illumination, adjustment of the shutter speed of the imaging sections, gain control and control of white balance (col. 18 lines 5-12).

Regarding claim 9, Bacus discloses at least the characteristics of an observation subject is set with the simple observation condition setting section (col. 5 lines 40-50).

Regarding claim 12, Bacus discloses a photographing means (14) for photographing an observation image from an observation subject.

Regarding claim 13, Bacus disclose an illumination means (168) for illuminating the observation subject.

Regarding claims 16 and 17, Bacus discloses wherein the illumination means comprises illuminating parts, and wherein the simple observation conditions comprise the condition that all parts of the illuminating parts are illuminated and/or the condition that one part of the illuminating part is illuminated (col. 17 lines 65-67).

Regarding claim 18, Bacus discloses the illumination means comprises a ring shaped illuminating part (174).

Regarding claim 20, Bacus discloses the simple observation image display section for displaying a plurality of simple observation images is a simple observation image display section for displaying simultaneously on the same display screen the simple observation image display section a plurality of simple observation images and wherein the plurality of simple observation images is photographed by the photographing means (Fig. 3).

Regarding claim 21, Bacus discloses the simple observation condition of the simple observation condition setting means are set automatically (col. 3 lines 55-65).

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Regarding claim 22, Bacus discloses the simple observation condition of the simple observation condition setting means are set arbitrarily (col. 3 lines 55-65). This claim limitation is inherent prior to or during the adjustment of the simple observation settings. Further, arbitrary does not necessarily mean settings cannot be automatic therefore the automatic setting of Bacus could be arbitrary.

Regarding claim 23, Bacus discloses the simple observation conditions comprise the condition of the incident light illuminating and the condition of a transmitting illumination (Fig. 9B and 10).

Regarding claim 24, Bacus discloses the simple observation condition of a filter being present (Fig. 9B and 10). The claim limitation that a filter is “preferably a polarizer or a diffuser” does not limit the filter to either of those categories, therefore the neutral density filters of Bacus meet the claim limitations.

Regarding claim 26, Bacus discloses a menu for setting the simple observation condition is displayed on the screen (Fig. 31).

Regarding claim 27, Bacus discloses varying the illumination conditions of the observation subject (Fig. 9B). The neutral density filters of Bacus would change the illumination conditions.

Regarding claim 30, Bacus discloses a display means for displaying an observation image based on a signal acquired by the photographing means (Figs. 2 and 3).

*Claim Rejections - 35 USC § 103*

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 15, 19, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacus (US 6,396,941) in view of Fairley (US 2002/0118359).

Bacus teaches the invention as claimed but lacks reference to changing the illumination angle. Fairley teaches the use of a microscope with a means to switch the direction of illumination (Fig. 5). Fig. 5 shows laser (523) having an adjustable angle and thus having a plurality of different angles of illumination. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Bacus invention include an adjustable angle illuminating device as taught by Fairley for the purpose of providing the images obtained by Bacus some three-dimensional characteristics based on shading that would occur as the light moved across the surface of the observation subject.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bacus (US 6,396,941).

Bacus teaches the invention as claimed but lacks reference to the simple observation display section and the observation display section. The claimed relationship is achievable by a mere duplication of parts. It has been held that it is within the skill of one of ordinary skill in the



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art at the time the invention as made to perform a duplication of parts. In the instant case one would have been motivated to perform the duplication of parts for the purpose of easier manufacturing by being able to assemble the two sections at the same time separately and later insert them into the overall system at two different locations.

### *Response to Arguments*

Applicant's arguments filed August 11, 2005 have been fully considered but they are not persuasive.

Applicant argues that the objection should be withdrawn because the two terms are such that one of ordinary skill in the art would understand the difference in the terms. The examiner has maintained the objection. The examiner still feels that the terms are confusing to one of ordinary skill in the art. One term is preceded by an adjective while the other is not. When the term without the adjective is used it is not readily apparent which term the applicant is intending to use. In addition to the suggestions above the examiner also suggests the addition of "second" to the term without a preceding adjective while maintaining the adjective "simple" for the other term. Support for this amendment is found in the original drawings of the application which show the presence of two observation image display sections.

Applicant argues that the Bacus reference only scans the entire microscopic image and does to provide a plurality of images based on altering of observation conditions. Change of location is an observation condition. There is also no claim limitation to limit the scan to a particular area.

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Applicant argues that Bacus does not provide multiple images of the same subject for subsequent selection of the most desired image for further processing. This limitation is not present in the claims. Therefore, this argument is moot.

Applicant argues that varying the magnification is not an observation condition as defined in claim 1. Claim 1 only states "observation conditions" which can be any portion of observation. There is no enumerated list of conditions set forth in the claim limitations. Therefore, magnification is an observation condition as defined by the claim language of claim 1.

Applicant's arguments, see Amendment, filed August 11, 2005, with respect to claims 7 and 8 have been fully considered and are persuasive. The objection of claims 7 and 8 has been withdrawn. Claims 7 and 8 still depend from claim 1 and are still objected to based on their dependence from claim 1.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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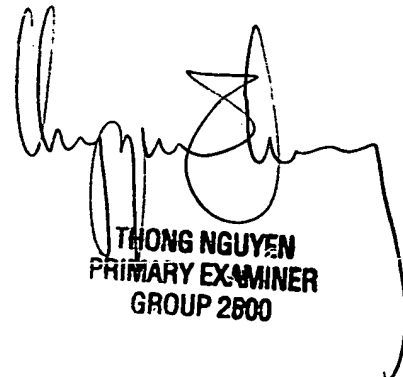
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP 

  
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